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EXAMINER	
SHRESTHA, BIJENDRA K	
ART UNIT	PAPER NUMBER
3691	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/816,120	GAUBATZ ET AL.	
	Examiner	Art Unit	
	BIJENDRA K. SHRESTHA	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,21-30 and 44-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10, 21-30 and 44-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-44 are presented for examination. With response to restriction requirement set by the Examiner, Applicant elected Group I, claims 1-10, 21-30 and 44-46 without traverse in a reply filed on July 7, 2008. Claims 11-20 and 31-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 1, as best understood, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr,* 450 U.S. 175, 184 (1981); *Parker* v. *Flook,* 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson,* 409 U.S. *63,* 70 (1972); *Cochrane* v. *Deener,* 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the

subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21-30 and 44-46 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claims 21 and 44 recite in the preamble “a computerized system”, the body of the claim does not contain any limitations indicating the structure of the system. A system or an apparatus claim should always claim the structure or the hardware that performs the function. Applicant’s claimed limitations consist of “means for…” (software according to the specification) that do not describe the structure of the device. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-10 and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flagg, U.S. Patent No. 6,456,979 (reference A in attached PTO-892) in view of Moller et al. (BMJ, June 1995) (reference U in attached PTO-892).

6. As per claim 1 and 21, Flagg teaches a computerized system and method of characterizing relative risks associated with a plurality of financial products, comprising the steps of:

a) identifying one or more risk classes associated with the plurality of financial products (see Fig. 2, step 60 (gender based risk class), step 80 (lifestyle/health profile base risk class));

Flagg does not teach b) determining, for each of the risk classes, an expected occurrence rate; c) dividing the expected occurrence rates determined in step b by an average rate to determine a relative risk ratio for each of the risk classes.

Moller et al. teach b) determining, for each of the risk classes, an expected occurrence rate ; c) dividing the expected occurrence rates determined in step b by an average rate to determine a relative risk ratio for each of the risk classes (Moller et al., Table, Expected, Relative Risk, paragraph 3; where expected occurrence and relative risk ratio of cancer in Denmark for period 1977-89 is shown).

d) comparing the relative risk ratios (Moller et al, Table, Relative Risk column, page 1, paragraph 4; where relative ratio of different types of cancer are compared; the remaining sentence in the claim "to characterize the relative risks associated with the plurality of products" represents intended use and therefore do not carry any patentable weight).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include b) determining, for each of the risk classes, an expected occurrence rate; c) dividing the expected occurrence rates determined in step b by an average rate to determine a relative risk ratio for each of the risk classes; and d) comparing the relative risk ratios of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks large cohorts of patients (or plurality of products).

7. As per claim 2 and 22, Flagg in view of Moller et al. teach claim 1 as described above. Flagg further teach the system and method, wherein

said one or more risk classes are associated with one or more criteria, and further comprising the steps of modifying one or more of said criteria (see Fig. 2; where risk classes are based on gender and lifestyle/health profiles (the remain claim language “repeating steps b, c and d to determine an impact of said modification on the relative risks associated with the products" is intended use that do not carry patentable weight).

8. As per claim 3-5 and 23-25, Flagg in view of Moller et al. teach claim 1 as described above. Flagg further teach the system and method, wherein

one or more of said risk classes are associated with different criteria (see Fig. 2; where risk classes are based on gender and lifestyle/health criteria)

Flagg does not teach relative risk ratios are used to compare said risk classes, the step of using the relative risk ratio to redefine one or more of said risk classes and the step of determining a separate relative risk ratio for sub-groups of risks.

Moller et al. teach relative risk ratios are used to compare said risk classes, the step of using the relative risk ratio to redefine one or more of said risk classes and the step of determining a separate relative risk ratio for sub-groups of risks (Moller et al, Table, Relative Risk column, page 1, paragraph 4; where relative ratio of different types of cancer risks are compared).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include relative risk ratios are used to compare said risk classes of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks large cohorts of patients (or plurality of products).

9. As per claim 6 and 26, Flagg in view of Moller et al. teach claim 1 as described above. Flagg further teach the system and method comprising

the step of storing data relating to prevalence of criteria associated with said risk classes (see Fig. 1; column 23, lines 23-29; where server stores insurance prevalence criteria as shown in Fig.2; "for use in determining the relative risk ratios" represents intended use).

10. As per claim 7and 27, Flagg in view of Moller et al. teach claim 6 as described above. Flagg further teach the system and method comprising

the steps of comparing the prevalence data to industry empirical data for particular combinations of criteria and, if necessary, adjusting the stored data to agree with the empirical data (see Fig. 2, steps 70 and 90).

11. As per claim 8 and 28, Flagg in view of Moller et al. teach claim 1 as described above. Flagg further teach the system and method, comprising

the step of storing data relating to the expected occurrence rates (see Fig. 1, client data server; where server can store any data; "for use in determining the relative risk ratios" represents intended use).

12. As per claim 9 and 29, Flagg in view of Moller et al. teach claim 8 as described above. Flagg further teach the system and method, comprising

the steps of comparing the stored data to industry empirical data and, if necessary, adjusting the stored data to agree with the empirical data (see Fig. 2. lines 48-53; Fig.12, column 25, lines 5-9).

13. As per claim 10 and 30, Flagg in view of Moller et al. teach claim 2 as described above. Flagg further teach the system and method,

Flagg does not the step of using the relative risk ratio (" to determine an impact on a risk class of including in that class one or more risks that do not meet one or more of the criteria associated with that class" represents intended use).

Moller et al. teach the step of using the relative risk ratio (Moller et al, Table, Relative Risk column, page 1, paragraph 4; where relative ratio of different types of cancer are compared).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the step of using the relative risk ratio of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks of large cohorts of patients (or plurality of products).

14. As per claim 44, Flagg in view of Moller et al. teach claim 1 and 21 as described above.

Flagg further teaches d) means for comparing the risk (see Fig. 2; where risk compared include gender and lifestyle/health based)

Moller et al. do not teach comparing relative risk ratio of the individual to the relative risk ratio of the risk class ("to determine whether to include the individual risk in, or exclude the individual risk from, the risk class" represents intended use).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include comparing relative risk ratio of the individual to the relative risk ratio of the risk class of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks of large cohorts of patients (or plurality of products).

15. As per claim 45, Flagg in view of Moller et al. teach claim 44 as described above. Flagg further teach the system, wherein

one or more of said risk classes are associated with a plurality of criteria (see Fig. 2, step 60 (gender based risk class), step 80 (lifestyle/health profile base risk class);

Flagg does not teach determining relative risk ratios for subgroups of criteria and means for comparing the relative risk ratio of the individual to the relative risk ratio of the risk class comprises comparing the relative risk ratio of the individual to one or more of the relative risk ratios determined for the subgroups of criteria.

Moller et al. teach determining relative risk ratios for subgroups of criteria and means for comparing the relative risk ratio of the individual to the relative risk ratio of the risk class comprises comparing the relative risk ratio of the individual to one or more of the relative risk ratios determined for the subgroups of criteria (Moller et al, Table, Relative Risk column, page 1, paragraph 4; where relative ratio of different types of cancer risks are compared including subgroups other skin cancer, all other specified cancer and cancer associated with tobacco smoking).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include determining relative risk ratios for subgroups of criteria and means for comparing the relative risk ratio of the individual to the relative risk ratio of the risk class comprises comparing the relative risk ratio of the individual to one or more of the relative risk ratios determined for the subgroups of criteria of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks large cohorts of patients (or plurality of products).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon;

Abrahams et al. (U.S. Pub No. 2002/0007329) teach system for managing risk.

Buckner et al. (U.S. Pub No. 2003/0236685) teach preferred life mortality systems and methods.

DeTore et al. (U.S. Patent No. 4,975,840) teach method and apparatus for evaluating a potentially insurable risk.

Gaubatz et al. (U.S. Pub No. 2003/0101132) teach system and method for developing loss assumptions.

Gunewardena et al. (U.S. Pub No. 2003/0023543) teach method, software program, and system for ranking relative risk of plurality of transactions.

Fickes (U.S. Pub No. 2005/0262014) teaches relative valuation systems.

Messmer et al. (U.S. Pub No. 2004/0225587) teach risk categorization in underwriting a financial risk instrument application.

Otvos (U.S. Patent no. 6,576,471) teaches analyzing risk assessment result.

Robertson et al. (U.S. Pub No. 2004/0024620) teach risk classification methodology.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571) 270-1374. The examiner can normally be reached on 8:00 AM-4:30 PM (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
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